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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/573,234	12/06/2006	Richard Jeffrey Jordan	AC00047-006 (26668-117)	7655
73824 7590 11/12/2010 Armstrong Teasdale LLP (IGT - 26668) Robert B. Reeser, III 7700 Forsyth Boulevard Suite 1800 St. Louis, MO 63105			EXAMINER BEKERMANN, MICHAEL	
			ART UNIT 3622	PAPER NUMBER
			NOTIFICATION DATE 11/12/2010	DELIVERY MODE ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

USpatents@armstrongteasdale.com

<b>Office Action Summary</b>	<b>Application No.</b> 10/573,234	<b>Applicant(s)</b> JORDAN ET AL.	
	<b>Examiner</b> MICHAEL BEKERMAN	<b>Art Unit</b> 3622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-32 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-32 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>6/15/2009 and 8/21/2007</u> . | 6) <input type="checkbox"/> Other: ____.  |

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

1. **Claims 7 and 8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.**

**Regarding claim 7**, this is a system claim reciting a slave server, a master server, and a process. The servers are both structural limitations, however it is unclear what structure is being claimed with the recitation of "a process". System claims are supposed to recite and further limit structural components.

**Regarding claim 7**, this claim recites the limitation "the random number". There is insufficient antecedent basis for this limitation in the claim language.

**Regarding claim 8**, this is a system claim reciting a database, an interface "module", a plurality of distributed "sites", and a bonus "engine". The distributed "sites" comprise a "cache" and electronic gaming terminals. It is unclear, however, what structure is being claimed by any of these recitations. While a "terminal" might normally be construed as a structural limitation, it is unclear as to what Applicant intends by reciting "sites" as a limitation in a system claim, and therefore it is unclear if a "terminal" is simply a software application or an actual piece of hardware. System claims are supposed to recite and further limit structural components.

***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

**2. Claims 1-6 and 8-32 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.**

**Regarding claims 1-6 and 9-32**, based on Supreme Court precedent, a method/process claim must **(1)** be tied to a particular machine or apparatus (see at least *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876)) or **(2)** transform a particular article to a different state or thing (see at least *Gottschalk v. Benson*, 409 U.S. 63, 71 (1972)). A method or process claim that fails to meet one of the above requirements is not in compliance with the statutory requirements of 35 U.S.C. 101 for patent eligible subject matter. Here the claims fails to meet the above requirements because the steps are neither tied to another statutory class of invention (such as a particular apparatus) nor physically transform underlying subject matter (such as an article or materials) to a different state or thing.

**Regarding claim 8**, as best understood, this claim appears to be programming (or possibly merely data) per se, and is not statutory. MPEP 2106.01 describes why a claim to functional descriptive material is non-statutory. This claim sets forth a system of some type comprising various pieces of software (database, module, "sites", cache, engine, and terminals, which as explained above is considered to be software for the

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reasons above). These pieces of software appear to be nothing more than programming instructions that are not clearly embodied on a computer readable medium. Examiner recommends positively reciting structure in the system claim. Please reference MPEP 2106.01 for the basis of this rejection.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. **Claims 1-8 are rejected under 35 U.S.C. 102(b) as being anticipated by Boushy (U.S. Patent No. 5,761,647).** Boushy discloses a system and method of awarding bonuses to users that include all of the limitations recited in the above claims.

**Regarding claim 1**, Boushy discloses collecting player data at a plurality of sites and compiling the data(Column 2 Line 45 – Colum 3 Line 22) selecting a device and awarding a bonus to the player of the device by generating an indication of the bonus (Column 5 Lines 53-64 and Column 8 Lines 8-25).

**Regarding claims 2 and 3**, Boushy discloses a master server and slave servers networked together to compile data (Figures 2A-2C).

**Regarding claim 4**, devices are selected based on a user playing the device, not based on any kind of pay table (Column 5 Lines 53-64).

**Regarding claim 5**, Boushy discloses selecting a player from among numerous players in a casino, all of which may also be members of the system, and therefore “identified” (Column 6 Lines 46-67 and Claim 8).

**Regarding claim 6**, Boushy discloses compiling wagering data on each terminal having an identified player (Column 5 Lines 53-64).

**Regarding claim 7**, Boushy discloses a master server and slave servers networked together to compile wagering data (Figures 2A-2C), and awarding a bonus based on exceeding numerous random thresholds (Column 12 Line 5 - Column 13 Line 5).

**Regarding claim 8**, Boushy discloses a patron management database including player activity, points, and point redemptions (Column 14 Lines 51-65 and Column 10 Lines 45-54), a number of interface modules connected through a wide area network (Figure 3), a plurality of sites having player caches and gaming terminals (Column 5 Lines 53-64 and Column 8 Lines 8-25), and a bonus engine that transmits payment instructions to a player responsive to play at gaming terminals (Column 8 Lines 8-25).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**4. Claims 9-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Boushy (U.S. Patent No. 5,761,647).**

**Regarding claims 9 and 10**, while Boushy discloses various types of gambling, Boushy does not appear to specify pari-mutuel betting such as track betting. However, Official Notice is taken that pari-mutuel and track gambling are old and well known. Pari-mutuel betting was said to be first used in 1867, which pre-dates Applicant's invention. The Kentucky Derby started using pari-mutuel betting for track races in 1908, which also pre-dates Applicant's invention. It would have been obvious to one having ordinary skill in the art at the time the invention was made to award bonuses on pari-mutuel betting. This would attract more users with a larger variety of bonus-ready games.

**Regarding claim 11**, Boushy teaches storing past player wagering activity (Column 11 Lines 27-33 and Column 12 Line 55 - Column 13 Line 5), transferring player data to a local cache responsive to local wagering (Column 2 Lines 6-24), tracking current player wagering (Column 5 Lines 53-64), and awarding a bonus responsive to play criteria exclusive of outcome (Column 12 Line 55 - Column 13 Line 5).

While Boushy discloses various types of gambling, Boushy does not appear to specify pari-mutuel betting. However, Official Notice is taken that pari-mutuel is old and well known. Pari-mutuel betting was said to be first used in 1867, which pre-dates Applicant's invention. It would have been obvious to one having ordinary skill in the art at the time the invention was made to award bonuses on pari-mutuel betting. This would attract more users with a larger variety of bonus-ready games.

**Regarding claim 12**, Boushy discloses play criteria as an amount of wagers over a predetermined time period (Claim 1).

**Regarding claims 13-18**, Boushy discloses an award redeemable at a number of sites (Abstract), but does not appear to specify bonuses such as free race wagers, free multi-use wagers, electronic drawings, or randomly awarded amounts funded by wagers. However, the type of reward given does not affect the steps taken in the method. In other words, the steps of the method will be performed the same regardless of the type of award. Further, it's well known that offering multiple options of bonuses will encourage a greater number of patrons to use the service in question. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to offer any number of rewards, including those recited in the claim language, to entice a greater number of patrons having differing tastes in rewards to gamble at the casinos of Boushy.

**Regarding claims 19-23, 26, and 27**, Boushy discloses multiple ways of determining player eligibility. Boushy teaches that tracked players are eligible for the bonus (Column 9 Lines 40-53). Boushy further specifies time periods of eligibility for wagering and visits (Column 12 Line 5 - Column 13 Line 5). Boushy further teaches a number of winning wagers (Column 12 Line 55 - Column 13 Line 5), as well as the wagering of a certain amount during a specific type of wagering (at the casinos in question) within a specific time frame (Column 12 Line 5 - Column 13 Line 5).

**Regarding claims 24 and 25**, while Boushy discloses various types of gambling and multiple ways of determining player eligibility, including placing any type of wager,



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Boushy does not appear to specify pari-mutuel betting such as track betting. However, Official Notice is taken that pari-mutuel and track gambling are old and well known.

Pari-mutuel betting was said to be first used in 1867, which pre-dates Applicant's invention. The Kentucky Derby started using pari-mutuel betting for track races in 1908, which also pre-dates Applicant's invention. Daily Double, Exacta, Quinella, Trifecta, and Pick Three are all types of horse racing bets. It would have been obvious to one having ordinary skill in the art at the time the invention was made to award bonuses on pari-mutuel betting. This would attract more users with a larger variety of bonus-ready games.

**5. Claims 28-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Boushy (U.S. Patent No. 5,761,647) in view of Olsen (U.S. Patent No. 6,210,275).**

**Regarding claims 28-30**, Boushy discloses storing user betting activity and awarding a bonus to a user based on wagering activity (Column 12 Line 55 - Column 13 Line 5). The bonuses of Boushy are awarded at any time regardless of winning outcomes, and therefore the bonuses may be given before, after, or at the same time wagers are placed.

Boushy doesn't appear to specify storing a selected outcome and awarding a payout based on the selected outcome and a future event. Olsen, however, discloses an electronic horse racing game in which players select an outcome (selection in an electronic device would have to be stored and such storage is considered a database)

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and awarding a payout based on a future event (Column 5 Lines 45-60). It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide a gaming apparatus such as that of Olsen, as such an apparatus might be viewed as fun and could attract further patrons.

**Regarding claim 31**, while Boushy discloses indicating bonuses electronically on a terminal (Column 8 Lines 8-25), Boushy does not appear to specify printing of a ticket listing an awarded bonus. However, Official Notice is taken that printers are old and well known. Hewlett Packard has been developing desktop printers to accompany desktop computers long before the filing of Applicant's invention. It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide a printer in the terminals and kiosks of Boushy in the interest of allowing a user to print any type of information needed, including bonus information.

**Regarding claim 32**, Boushy does not appear to specify a bonus being determined by a winning outcome. Olsen, however, discloses playing a "bonus game" to receive a bonus, where the outcome of the bonus game would determine the bonus (Abstract). It would have been obvious to one having ordinary skill in the art at the time the invention was made to determine a bonus either based on the outcome of a game, or regardless of an outcome of a game. Casinos might choose either option depending on marketing strategy or future goals and outlook.

***Conclusion***

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to MICHAEL BEKERMAN whose telephone number is (571)272-3256. The examiner can normally be reached on Monday - Thursday, 9:00 - 3:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric W. Stamber can be reached on (571) 272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Michael Bekerman/  
Primary Examiner, Art Unit 3622